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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/883,357
Filing Date: June 19, 2001
Appellant(s): FABER, LOTHAR K.

Jason C. Beckstead
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on July 22, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 7-9 and 20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,697,893	FEHR et al	10-1987
6,226,118	KOYAMA et al	5-2001

(10) Grounds of Rejection

Claims 1, 7-9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fehr et al (U.S. Patent No. 4,697,893) in view of Koyama et al (U.S. Patent No. 6,226,118).

Fehr et al disclose a microscope system having an objective lens changer (10), a microscope body (6) for supporting optical elements such as an image variable magnification system (21 and 22) and another microscope body (7) for supporting other optical components such as a prism system (23) and an eyepiece system (25). See columns 2-3 and figs. 1-2. The objective lens changer (10) as described in columns 3-4 comprises a plate (11) supporting two different objective lens systems including a stereoscopic objective lens system (8) and a binocular lens system (9). The slide (11) is able to swap the stereoscopic objective lens system (8) with the binocular objective lens system (9) and vice verse. See column 3, lines 45+ through column 4, line 38). The only feature missing from the microscope provided by Fehr et al is that they do not discloses that the microscope has an illumination system comprises a light transmitted system and a fluorescent system. However, the use of a microscope system having such an illumination system wherein the microscope comprises a mechanism for switching different kind of objective lens systems into the viewing path of a microscope is clearly suggested to one skilled in the art as can be seen in the system provided by Koyama et al. For instance, in the embodiment described in column 14 and shown in figure 12, Koyama et al disclose a

microscope having an illumination system comprises 1) a light transmitting illumination (63) for providing a bright illuminating pattern to an object, and a fluorescent illumination system (56) for providing excited light to activate fluorescent illumination in the object, and 2) a mechanism (8) supporting different objective lens systems in which a particular objective lens system is selectably inserted into the viewing path of the microscope. The switching operation of the selective objective lens system into the viewing path of the microscope could be made in an automated fashion via a motorized system. See column 14. It is also noted that the use of rotatable turret/revolving supporting different objective lens systems is also suggested by Koyama et al as can be seen in the embodiments described in columns 11-12 and shown in figures 8 and 11a, for example. It is also noted that the use of a slider or a turret for supporting more than two objective lens systems is also known to one skilled in the art. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the microscope having an objective lens changer provided by Fehr et al by using an illumination system having both a light transmitted illumination system and a fluorescent illumination system, and a motorized mechanism as suggested by Koyama et al for the purpose of automation the switching of the different objective lens systems in either a bright illumination or a fluorescent illumination.

(11) Response to Argument

Appellant's arguments filed on the Appeal Brief of July 22, 2004 have been fully considered but they are not persuasive for the following reasons.

A) Regarding to the first issue related to the rejection of claim 1 under 35 USC 103(a) over the art of Fehr et al and Koyama et al, Appellant's arguments as provided in the Brief, pages 5-10 have been fully considered but they are not persuasive.

First, regarding to the Appellant's arguments that the Examiner has failed to analyze important secondary considerations related to the copy of the present invention by a competitor presented by the Appellant in the communication of October 9, 2003 (see Appeal Brief, pages 5-8). The Examiner respectfully disagreed with the Appellant's conclusions. The Examiner has indeed considered the Declaration filed under Rule 37 CFR 1.132 and the Appellant's arguments listed in the communication of October 9, 2003; however, the Examiner has stated that such a filing of the Declaration and the Appellant's arguments filed on October 9, 2003 have not been sufficient to overcome the rejection of the present application as claimed in the present claims with the combined product provided by Fehr et al and Koyama et al because Appellant has failed to provide written evidences to show that the competitor has tried for a substantial length of time to design a product similar to the claimed invention, but failed and then copied the claimed invention instead. The appellant is respectfully invited to review the (Final) Office action mailed to the Appellant on 1/12/2004, pages 5-6, in particular

in page 6, in which the Examiner has stated: "With regard to applicant's arguments concerning the copy of the inventive device by different party as stated in the Declaration, applicant's bare statement that a different party is copied the inventive device as stated is not sufficient because applicant has failed to file written evidence to show that the party has tried for a substantial length of time to design a product similar to the claimed invention, but failed and then copied the claimed invention instead."

Appellant is respectfully invited to review the MPEP, Section 716.06, which states: "Evidence of copying was persuasive of nonobviousness when an alleged infringer tried for a substantial length of time to design a product or process similar to the claimed invention, but failed and then copied the claimed invention instead. *Dow Chem. Co. v. American Cyanamid Co.*, 837 F.2d 469. 2 USPQ2d 1350 (Fed. Cir. 1987). Alleged copying is not persuasive of nonobviousness when the copy is not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution..."

Second, in response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Regarding to the Appellant's arguments that the combined art does not disclose all of the features recited in the present claims (see Appeal brief, pages 9-10), the Examiner respectfully disagrees with the

Appellant's opinion. The Appellant is respectfully invited to review the rejection as set forth in the previous Office action and repeated in this Examiner's answer which showed that all of the features claimed in the present claims are disclosed in the combined product provided by the teachings of Fehr et al and Koyama et al. In particular, the features relating to the microscope body, the objective housing, the stereo objective, the compound objectives, the means for changeover the types of objectives are disclosed in the microscope provided by Fehr et al, and the features relating to the bright field illumination and fluorescent illumination, and the feature of changing objectives in an automated fashion are provided by Koyama et al.

Appellant should also note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Appellant's arguments that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596

(Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references of Fehr et al and Koyama et al are directed to microscopes having means for changeover different types of optical elements including different objective lens systems for the purpose of providing different types of observations. The teaching, i.e., the types of illuminations, provided by Koyama et al is used by the Examiner in the combination to show to one skilled in the art that different types of illumination can be used in a microscope having means for changeover different optical components of a microscope and the types of illuminations are able to select from either a bright field illumination or a fluorescent illumination. Either type of illumination is used with the selection of a stereoscopic objective or a compound objective.

B) Regarding to the second issue related to the rejection of claim 7 under 35 USC 103(a) over the art of Fehr et al and Koyama et al, Appellant's arguments as provided in the Brief, page 10 have been fully considered but they are not persuasive.

Appellant has argued that neither Fehr et al or Koyama et al teach of suggest the use of a second compound objective wherein an objective housing is enabled to swap any of the stereo objective, a first compound objective and a second compound objective objectives in a viewing path of the microscope. The Examiner offers the following opinion.

The microscope provided by Koyama et al comprises a housing supporting a plurality of objective lenses wherein a particular objective lens is inserted into the

viewing path of the microscope via an automated fashion. The support for that conclusion is found in columns 14-15 of the Koyama et al patent. The Appellant is respectfully invited to review column 14, lines 37-65 which discloses a revolver (81) for supporting an objective lens (82) of 0.5X magnification and a plurality of objective lenses (83) with optical features differ from that of the objective lens (82). The revolver supports a plurality of objective lenses grouped into two kinds of different objective lenses in which one kind of objective lens comprises plural objective lenses would suggest to one skilled in the art to use a revolver supporting a plurality of objective lenses including more than one compound objective lens in the system of Fehr et al so that a user can have an observation of an object with a different kind of compound objective lens of different optical feature.

C) Regarding to the third issue related to the rejection of claims 8 and 20 under 35 USC 103(a) over the art of Fehr et al and Koyama et al, Appellant's arguments as provided in the Brief, pages 10-11 have been fully considered but they are not persuasive.

Appellant has argued that each of the claims recites an objective housing swaps the objectives in an automated fashion, and the Examiner has failed to amount a prima facie of obviousness then the rejection is improper. The Examiner respectfully disagrees with the Appellant's opinions and offers the following opinion.

The microscope provided by Koyama et al comprises a housing supporting a plurality of objective lenses wherein a particular objective lens is inserted into the viewing path of the microscope via an automated fashion. The support for that conclusion is found in columns 14-15 of the Koyama et al patent. The appellant is respectfully invited to review column 14, lines 37-65 which discloses a revolver (81) for supporting an objective lens (82) of 0.5X magnification and a plurality of objective lenses (83) with optical features differ from that of the objective lens (82) wherein the revolver (81) is rotated about an optical axis by a motorized mechanism having a motor (65), a shaft (651), a gear (652), etc...As a result of an operation of the motorized mechanism, the revolver is enabled to insert a particular objective lens into the viewing path of the microscope by an automated fashion.

Fehr et al disclose a microscope having a mechanism for swapping a particular objective lens out of a set of objective lenses into the viewing path of a microscope. While Fehr et al do not disclose the movement of the selected objective lens into the viewing path of a microscope is made by an automated fashion; however, a mechanism for changing objective lenses in a microscope in an automated fashion is disclosed in the art by Koyama et al which device is from the same field of endeavour as that of Fehr et al, it would have been obvious to one skilled in the art to modify the mechanism for changing the objective lenses in the microscope provided by Fehr et al by using a mechanism for changing the objective lenses by an automated fashion as suggested by Koyama et al for the

purpose of inserting a particular objective lens into the viewing path faster and more controllable.

D) Regarding to the fourth issue related to the rejection of claim 9 under 35 USC 103(a) over the art of Fehr et al and Koyama et al, Appellant's arguments as provided in the Brief, pages 11-12 have been fully considered but they are not persuasive.

Appellant has argued that the prism mechanism used in the microscope provided by Fehr et al is moved by a manually sliding mechanism while the movement of the prism device as claimed in claim 9 is an automated movement. The Examiner respectfully disagrees with the Appellant for the following reasons. First, the present claim 9 has never positively recited an automated mechanism for moving the prism mechanism. Claim 9 recites a prism mechanism *capable of being positioned in an automated fashion* (Examiner's emphasis). Appellant should note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. Further, the movement of the prism mechanism in the path of a single axis compound image for creating binocular images as disclosed by Fehr et al is capable to perform by an automated fashion because the art of Koyama et al clearly disclose the use of a motorized mechanism for inserting a particular objective lens into the viewing path by an automated fashion. Appellant should also note that the prism mechanism (44) and the objective lens (41) are formed into a single objective lens element (9). See Fehr et al, columns 3-4.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Thong Q Nguyen
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September 30, 2004

Conferees

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